

REMARKS

I. Status of the Claims

In the Office Action mailed May 27, 2009, the Examiner: (1) rejects claims 1-3, 6-11, 13-18, 21-26, and 28-30 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and (2) rejects claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 under 35 U.S.C. § 103(a), as being unpatentable over *Marshall* (U.S. Patent Application Publication No. 2002/0116266) in view of *Walker et al.* (U.S. Patent No. 6,018,718), and in view of *COSTCO* (Scally, Robert, "The charge of the family-size bridge: Costco to accept AmEx payments," Discount Store News: Aug. 23, 1999).

By this Amendment, Applicant amends claims 1, 16-18, 22-26, 28, and 31. Claims 4, 5, 12, 19, 20, 27, 34, 35, and 42 were previously canceled. Claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 remain pending in this application. By the following remarks, Applicant respectfully traverses the rejections contained in the Office Action.

II. Rejection of Claims 1-3, 6-11, 13-18, 21-26, and 28-30 Under 35 U.S.C. § 101

Applicant respectfully traverses the Examiner's rejection of claims 1-3, 6-11, and 13-15 under 35 U.S.C. § 101, as being directed to non-statutory subject matter. The Examiner applied the "machine-or-transformation" test and alleges that the recitation of "using the computer system" in claim 1 does not tie the method to a machine. (Office Action at p. 3.) Applicant respectfully disagrees. However, in order to advance prosecution, Applicant has amended claim 1 to recite "by the computer system." Therefore, the amended claim 1 and its dependent claims 2, 3, 6-11, and 13-15 meet the "machine-or-transformation" test set forth by the Federal Circuit in *In re Bilski*. *In re*

Bilski, 545 F.3d 943 (Fed. Cir. 2008) (*en banc*). Accordingly, Applicant requests that the Examiner withdraws the 35 U.S.C. § 101 rejection and allow claims 1-3, 6-11, and 13-15.

Applicant also respectfully traverses the Examiner's rejection of claims 16-18, 21-26, and 28-30 under 35 U.S.C. § 101, as being directed to non-statutory subject matter. The Examiner alleges that the "components" recited by claim 16 are software per se, and thus, do not fall within a statutory category of invention. (Office Action at p. 3.) Applicant respectfully disagrees. However, solely to advance prosecution, Applicants have amended claim 16 to recite "a memory," and "a processor connected to the memory," which are both clearly statutory "machines" under 35 U.S.C. § 101. Therefore, amended claim 16 and its dependent claims 17, 18, 21-26, and 28-30 are directed to statutory subject matter. Accordingly, Applicant requests that the Examiner withdraws the 35 U.S.C. § 101 rejection and allow claims 16-18, 21-26, and 28-30.

III. Rejection of Claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 under 35 U.S.C. § 103(a).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in

the art.” M.P.E.P. § 2141(III). A *prima facie* case of obviousness has not been established at least because the Examiner does not correctly determine the scope and content of the prior art, or correctly ascertain the differences between the claimed invention and the cited references. The Examiner has not properly determined the scope and content of the prior art, at least because *Marshall*, *Walker et al.*, and *COSTCO*, taken individually or in any proper combination, fail to disclose or suggest all the elements of amended claim 1,

Marshall is directed to “incentive rewards programs for influencing a variety of desirable behaviors.” *Marshall* at para. [0006]. The programs are “maintained by a program administrator,” such as “a computer system,” connected with various “computer systems of program participants.” *Marshall* at para. [0033]. The incentive rewards program “reward[s] the time and timing of the occurrence of tasks, activities and other interactions” between the individuals and the participant organizations. *Marshall* at para. [0011]. For example, individuals enrolled in the incentive program “accumulate time points by engaging in activities specified by the programs” at “multiple participant organizations.” *Marshall* at para. [0031]-[0033]. “Such activities may include purchases, store visits, attending in person or remotely sales presentations, providing blood donations, cash or other donations, engaging in volunteer activities, or a range of other activity which may be desired.” *Marshall* at para. [0035].

In the Office Action, the Examiner appears to interpret *Marshall*’s “program administrator” as corresponding to the claimed “financial institute,” the “participant organization” as corresponding to the claimed “enterprise,” the “desirable behaviors” and “tasks, activities, and other interactions” as corresponding to the claimed “non-

credit activity," and the "time points" as corresponding to the claimed "reward." (Office Action at pp. 4-5.) Based on these interpretations, the Examiner further alleges that the claimed "relationship with the enterprise to reward a person," "soliciting ... the plurality of persons involved with the enterprise to associate a financial account with a reward," and "detecting non-credit behavior of the person," are either disclosed by *Marshall* or inherent. (Id.)

Conceding that *Marshall* is silent about a "financial account" and a "financial institute," the Examiner cites *Walker et al.* to allege the teaching of "awarding particularly financial accounts." (Office Action at p. 5.) Further, the Examiner acknowledges that *Marshall* and *Walker et al.* do not disclose that "a lower credit risk is associated with persons who engage in non-credit behavior benefiting the enterprise," as recited in claim 1. (Office Action at p. 6.) However, to alleviate this deficiency of *Marshall* and *Walker et al.*, the Examiner cites *COSTCO* for and alleges that *COSTCO* "discloses a credit card company awarding account holders a reduction in annual fees on their credit card account in exchange for account holder maintaining a *COSTCO* membership, which benefits *COSTCO*." (Id.)

Applicant respectfully disagrees with the Examiner's interpretation of the cited references. *Marshall*, *Walker et al* and *COSTCO*, alone or in any combination, do not teach or suggest at least "identifying an enterprise unrelated to the financial institution, wherein a lower credit risk is associated with persons who engage in non-credit behavior benefiting the enterprise," "receiving, from the enterprise and by the computing system, contact information identifying a plurality of persons involved with the enterprise after the enterprise determines that the relationship is advantageous to the enterprise,

wherein the plurality of persons are associated with a higher response rate to a soliciting offer presented by the financial institution than persons not related to the enterprise,” and “soliciting, by a financial institution, based upon the contact information and by the computing system, the plurality of persons involved with the enterprise to associate a financial account with a reward for engaging in the non-credit behavior benefiting the enterprise, wherein soliciting further includes notifying the plurality of persons of the relationship between the financial institute and the enterprise,” as recited by amended claim 1, nor is this recitation well known in the art.

First, *COSTCO* does not cure the deficiency of *Marshall* and *Walker* because, contrary to the Office Action’s contentions, *COSTCO* does not teach that “a lower credit risk is associated with persons who engage in non-credit behavior benefiting the enterprise,” as recited in claim 1. While *COSTCO* discloses “a co-branded American Express/Costco card ... issued for the price of a Costco membership” that has “a cash rebate program based on all spending done with the cards,” the reference does not teach or suggest that “a lower credit risk is associated with persons” who shop at Costco. *COSTCO* at most teaches that “both Costco and American Express cater to higher-income consumers,” which is different from lower credit risk consumers. *COSTCO* at p. 3, column 2, lines 5-6. Therefore, in contrast to the Examiner’s allegation, *Marshall*, *Walker et al* and *COSTCO*, alone or in any combination, do not teach or suggest at least the “identifying” element as recited in claim 1.

Furthermore, *Marshall* merely teaches that during the enrolling process, an individual can provide “individual profile information to [the] program administrator” (step 205 of FIG. 2), or to a “participant resource” such as a participant computer system

(step 215 of FIG. 2) which will forward the information to the program administrator. *Marshall* at FIG. 2 and para. [0080]. However, such profile information is not received after the “participant organization,” which the Examiner alleges as the claimed “enterprise,” “determines that the relationship is advantageous to the enterprise,” as recited by amended claim 1. Indeed, the “participant computer system” of *Marshall* makes no such determination at all. Moreover, *Marshall* also fails to teach or suggest that the individuals whose profile information is forwarded to the “program administrator,” which the Examiner alleges as claimed “financial institute,” “are associated with a higher response rate to a soliciting offer presented by” the “program administrator.” For at least these reasons, *Marshall* does not teach or suggest the “receiving” element as recited in amended claim 1. The other cited references, *Walker* and *COSTCO*, are likewise silent regarding this recited feature. And, this is another example of the many significant differences between the claimed invention as a whole and the cited reference.

In addition, although *Marshall* discloses that “[i]f the program determines that the individual is not an existing enrolled member, the individual is offered the option of enrolling in the program,” *Marshall* at para. [0013], it does not teach or suggest “notifying the plurality of persons of the relationship between the financial institute and the enterprise,” as recited by amended claim 1. Therefore, *Marshall* also fails to teach or suggest the “soliciting” element as recited in amended claim 1 and neither *Walker* nor *COSTCO*, nor the combination thereof, cures this deficiency of *Marshall*.

Consequently, the cited art fails to support the rejection of claim 1 and the Office Action has neither properly determined the scope and content of the prior art nor

properly ascertained the differences between the prior art and the claimed invention. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1. Applicants thereby respectfully request that the rejection of claim 1 be withdrawn and the claim allowed.

Amended independent claims 16 and 31, although of different scope than claim 1, recite similar subject matter. Accordingly, Applicants also respectfully request the withdrawal of the rejection of claims 16 and 31 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

Dependent claims 2, 3, 6-11, 13-15, 17, 18, 21-26, 28-30, 32, 33, 36-41, and 43-45 are also allowable at least for the reasons set forth above in connection with independent claims 1, 16, and 31, and because they additionally recite features neither taught nor suggested by the prior art of record. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 2, 3, 6-11, 13-15, 17, 18, 21-26, 28-30, 32, 33, 36-41, and 43-45 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

IV. Conclusion

The preceding remarks are based on the arguments presented in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any

such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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